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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/855,337

05/15/2001

Hirofaka Uchiyama

8085

1086

27752

7590

02/12/2007

THE PROCTER & GAMBLE COMPANY  
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EXAMINER

CHANNAVAJJALA, LAKSHMI SARADA

ART UNIT

PAPER NUMBER

1615

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
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3 MONTHS

02/12/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

**Office Action Summary**

Application No.

09/855,337

Applicant(s)

UCHIYAMA ET AL.

Examiner

Lakshmi S. Channavajjala

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**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --****Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 12-22-06.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-14, 16, 18-58 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-14, 16, 18-58 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

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### **DETAILED ACTION**

Receipt of terminal disclaimer and response dated 12-22-06 is acknowledged.

Claims 1-14, 16 and 18-58 are pending in the instant application.

#### ***Terminal Disclaimer***

The terminal disclaimer filed on 12-22-06 disclaiming the terminal portion of any patent granted on this application, which would extend beyond the expiration date of US 6,878,695 has been reviewed and is accepted. The terminal disclaimer has been recorded and accordingly the double patenting rejection made in the previous action dated 9-25-06 has been withdrawn.

However, upon careful consideration, the following new rejections have been applied to the pending claims 1-14, 16, 18-44 and 49-52.

#### ***Double Patenting***

Claims 1-14, 16 and 18-58 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over any of the claims 1-49 of U.S. Patent No. 5,968,404 ('404); claims 1-34 of U.S. Patent No. 6,284,231; claims 1-45 U.S. Patent No. 6,656,923; claims 1-25 U.S. Patent No. 5,955,093, in view of US 5408022. Although the conflicting claims are not identical, they are not patentably distinct from each other because of the following reasons:

Each of the above patents claim a composition comprising uncomplexed cyclodextrin, a cyclodextrin compatible surfactant and at least one antimicrobial

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active agent, in addition to ingredients such as a perfume, a buffering agent, etc., all of which are also claimed in the instant application. Instant claims require a cyclodextrin-incompatible surfactant, which according to the instant specification includes compounds such as cetylpyridinium chloride and dodecyltrimethylammonium bromide (page 31). According to the instant specification, the above surfactants are incompatible with cyclodextrin and possess the complexation constants and ClogP values that are within the claimed values of the instant dependent claims. Further, all of the above patents describe and also claim the same cyclodextrin compatible surfactants that are also described and claimed in the instant application. Accordingly, the properties such as the claimed complexation constants, critical micelle concentration etc., are inherent to the compatible surfactants of the above patented claims. While each of the above patents fail to recite a cyclodextrin incompatible surfactant, as claimed, the above patents are antimicrobial agents, which according to the disclosures of the above patents include compounds such as cetylpyridinium chloride and dodecyltrimethylammonium bromide.

Thus, while patents describe the compounds as antimicrobial agents, instant specification describes the same as surfactants. This is further evident from the teachings of U. S. Patent No. 5,408,022, which teaches that the antimicrobial agent, cetylpyridinium chloride is also known as a cationic surfactant.

Instant claims do not recite any specific surfactant or types of surfactants and instead generally recite cyclodextrin- incompatible surfactant, which

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encompasses the antimicrobial agents of the above-patented claims.

Accordingly, it would have been obvious for one of an ordinary skill in the art at the time of the instant invention to employ as an antimicrobial agent (such as cetylpyridinium chloride) in the composition of any of the above patents and still expect the claimed surfactant property because each of the above patents claim antimicrobial agents, which include those that possess the claimed surfactant property.

Claims 1-14, 16 and 18-58 are directed to an invention not patentably distinct from claims 1-49 of U.S. Patent No. 5,968,404 ('404); claims 1-34 of U.S. Patent No. 6,284,231; claims 1-45 U.S. Patent No. 6,656,923; claims 1-25 U.S. Patent No. 5,955,093, which are commonly assigned. Specifically, as explained above the composition of the instant claims are of the same scope as that patented in the above patents.

The U.S. Patent and Trademark Office normally will not institute interference between applications or a patent and an application of common ownership (see MPEP Chapter 2300). Commonly assigned patents recited in the preceeding paragraph, discussed above, would form the basis for a rejection of the noted claims under 35 U.S.C. 103(a) if the commonly assigned case qualifies as prior art under 35 U.S.C. 102(e), (f) or (g) and the conflicting inventions were not commonly owned at the time the invention in this application was made. In order for the examiner to resolve this issue, the assignee can, under 35 U.S.C. 103(c) and 37 CFR 1.78(c), either show that the conflicting

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inventions were commonly owned at the time the invention in this application was made, or name the prior inventor of the conflicting subject matter.

A showing that the inventions were commonly owned at the time the invention in this application was made will preclude a rejection under 35 U.S.C. 103(a) based upon the commonly assigned case as a reference under 35 U.S.C. 102(f) or (g), or 35 U.S.C. 102(e) for applications pending on or after December 10, 2004.

***Claim Rejections - 35 USC § 103***

Claims 1-14, 16 and 18-58 are rejected under 35 U.S.C. 103(a) as being obvious over claims 1-49 of U.S. Patent No. 5,968,404 ('404); claims 1-34 of U.S. Patent No. 6,284,231; claims 1-45 U.S. Patent No. 6,656,923; claims 1-25 U.S. Patent No. 5,955,093.

Each of the applied reference has a common inventor with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art only under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 103(a) might be overcome by: (1) a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not an invention "by another"; (2) a showing of a date of invention for the claimed subject matter of the application which corresponds to subject matter disclosed but not claimed in the reference, prior to the effective U.S. filing date of the reference under 37 CFR 1.131; or (3) an oath or declaration under 37 CFR 1.130 stating that the application and reference are currently owned by the same party and that the inventor named in

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the application is the prior inventor under 35 U.S.C. 104, together with a terminal disclaimer in accordance with 37 CFR 1.321(c). This rejection might also be overcome by showing that the reference is disqualified under 35 U.S.C. 103(c) as prior art in a rejection under 35 U.S.C. 103(a). See MPEP § 706.02(l)(1) and § 706.02(l)(2).

Each of the above patent is directed to cyclodextrin composition, employed for the same purpose i.e., absorption or capturing unwanted odor, comprising uncomplexed cyclodextrin compounds, cyclodextrin compatible surfactants, perfume, buffering agents and antimicrobial active agents. Above patents differ from the instant in that instant claims recite a cyclodextrin incompatible surfactant. As explained under the Double Patenting rejection, instant claims do not recite a particular cyclodextrin incompatible surfactant. On the other hand, the above patents describe antimicrobial agents that include cetylpyridinium chloride, which is also described in the instant specification as a cyclodextrin-incompatible surfactant. Thus, irrespective of the property (antimicrobial or surfactant), the same compound can be used with cyclodextrin for the same purpose i.e., capture of unwanted molecules. Accordingly, it would have been obvious for one of an ordinary skill in the art at the time of the instant invention to employ antimicrobial agents such as cetylpyridinium chloride as an antimicrobial agent in the composition of the above patents and achieve both an antimicrobial effect and also a surfactant effect because the above patents describe the compound for antimicrobial activity during absorbing odor from surfaces.

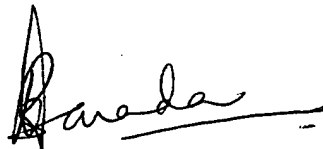
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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lakshmi S. Channavajjala whose telephone number is 571-272-0591. The examiner can normally be reached on 7.00 AM - 4.00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Woodward can be reached on 571-272-8373. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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February 6, 2007

  
**LAKSHMI S. CHANNAVAJJALA**  
**PRIMARY EXAMINER**